

REMARKS

Claims 38-41 are pending and at issue in the application.

This amendment is submitted in accordance with 37 C.F.R. §1.116(a) and §1.116 (b) in order to present the rejected claims in a better form for allowance or appeal. The amendment is necessary to eliminate rejections under 35 U.S.C. §112, second paragraph. This amendment was not presented earlier because applicants believed, and still believe, that Amendment "A" filed on June 9, 2003, overcame all outstanding rejections. This amendment should be entered because it places the application in better form for allowance or appeal, and the amendment does not require further searching or present any new issues.

Independent claim 38 has been amended to add definitions to the claim and to clarify the claim. The specific amendments are discussed in more detail below. Claim 41 has been rewritten as an independent claim, thereby overcoming all outstanding 35 U.S.C. §112, second paragraph, rejections of this claim.

Rejections Under 35 U.S.C. §112

Claims 38-41 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In view of the amendments to claims 38 and 41, and for the reasons set forth below, it is submitted that claims 38-41 fully conform to 35 U.S.C. §112. The individual rejections under 35 U.S.C. §112 are discussed separately below.

(iv) Claim 38 recites the term "substituted" with respect to recited the alkyl, heteroaryl, aryl groups. The examiner considers this term indefinite, but stated that the rejection would be withdrawn if applicants recite the groups disclosed in the specification. Accordingly, applicants have amended claim 38 to recite substituents for alkyl, heteroaryl, and aryl groups. Support for these amendments can be found in the specification at page 12, lines 7-16 and page 15, line 26 through page 16, line 2. Applicants also add a definition for "substituted heterocycloalkyl," which now is recited in the claim because of the addition of "R^a" to the claim, as discussed hereafter. Accordingly, it is submitted that the term "substituted" as used in claim 38 now is more clear, and that claim 38 complies with 35 U.S.C. §112.

(v) It also is submitted that the term "cycloalkyl" as now recited in claim 38 is clear and definite. In particular, the term "cycloalkyl" is defined at page 13, lines 1-5 of the specification as being a nonaromatic, hydrocarbon ring containing three to six carbon atoms. This feature has been incorporated into claim 38. Accordingly, it is submitted that the presently recited term "cycloalkyl" is clear and definite to persons skilled in the art and complies with 35 U.S.C. §112.

(vi) The term "heterocycloalkyl" also is considered indefinite. The definition of the term is set forth in the specification at page 15, lines 15-25. This definition also has been incorporated into claim 38. The claim now recites the total number of atoms, number of heteroatoms, and identity of the heteroatoms.

The definition in the specification does not encompass an "-alkyl-heterocycle," but refers to heterocycles. Like (iv) and (v) above, it is submitted that claim 38 complies with 35 U.S.C. §112, second paragraph.

(x) The examiner also considers the term "heteroaryl" indefinite. The specification contains a definition for "heteroaryl" at page 15, lines 6-14. This definition has been incorporated into claim 38. Claim 38 now recites an aromatic ring system, the number of atoms in the ring system, and the number and identity of the heteroatoms. Accordingly, it is submitted that as recited in claim 38, the term "heteroaryl" complies with 35 U.S.C. §112, second paragraph.

(xi) The examiner considers the term "acyl" indefinite. The term "acyl" is fully defined in the specification at page 12, lines 25-29, as $R^aC(=O)$, which is attached to the remainder of the molecule through the carbonyl group. The R^a moiety also is clearly disclosed. Claim 38 has been amended to delete the term "acyl," and the terms " $R^aC(=O)$ " and " R^a " have been added to the claim. Accordingly, it is submitted that claim 38 fully complies with 35 U.S.C. §112, second paragraph.

(xiii) With respect to taking R^1 and R^2 together, the resulting ring system is not aromatic. The ring can be saturated or partially unsaturated, as recited in claim 38. See, for example, Examples 78, 139-142, and 145-148, which provide support for this phrase. In other words, when R^1 and R^2 are taken together, the resulting bicyclic ring system contains the aromatic phenyl ring and the ring formed by R^1 and R^2 , which is nonaromatic, but can contain unsaturation.

In addition, a substituent on a nitrogen or phosphorus heteroatom is contemplated, i.e., a ring nitrogen or phosphorus atom having a substituent different from hydrogen. A sulfur or oxygen atom are incapable of substitution. In addition, it is difficult to foresee any other ring system beyond a monocyclic ring because only 5- and 6-membered rings are claimed.

To clarify claim 38, the claim has been amended to recite a "monocyclic" 5- or 6-membered ring, and that it is a nitrogen or phosphorus heteroatom that can be optionally substituted. These amendments are fully supported by Examples 78, 139-142, and 145-148. Accordingly, it is submitted that the amendment to claim 38 overcomes the rejection under 35 U.S.C. §112, second paragraph, with respect to taking R¹ and R² together to form a ring.

For all the reasons set forth above, it is submitted that claims 38-41 fully comply with 35 U.S.C. §112, second paragraph. Claim 41 now is in independent form. Claim 38 has been amended to recite definitions provided in the specification and to clarify the claim. As stated by the examiner, the rejection under 35 U.S.C. §112, second paragraph, therefore, should be withdrawn.

In summary, it is submitted that the claims are now in proper form and scope for allowance. Early and favorable action on the merits is respectfully requested.

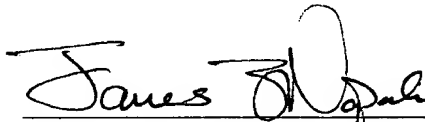
Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is

urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By

A handwritten signature in dark ink, appearing to read "James J. Napoli", is written over a horizontal line.

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